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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,226	10/30/2003	Per Vedso	6550.200-US	9782

23650 7590 06/14/2004

NOVO NORDISK PHARMACEUTICALS, INC
100 COLLEGE ROAD WEST
PRINCETON, NY 08540

EXAMINER

VOLLANO, JEAN F

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,226

Applicant(s)

VEDSO ET AL.

Examiner

Jean F. Vollano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 (in part), drawn to a compound and a process for preparing wherein the compound has Arylene defined as carbocyclic or aromatic hydrocarbon and Y is a boronic acid group, classified in class 562, subclass various.
- II. Claims 1-13(in part), drawn to compounds and process for preparing wherein the compound has Arylene defined as a carbocyclic or aromatic hydrocarbon and Y is a boronic ester wherein the ester is not a ring group (i.e. cyclic ester type), classified in class 558, subclass various.
- III. Claims 1-13(in part), drawn to compounds and process for preparing wherein the compound has an Arylene defined as a carbocyclic or aromatic hydrocarbon and Y is a not heterocyclic ester moiety selected from the (c), (d), (e), (f) and (g), classified in class 549, subclass various.
- IV. Claims 1-13(in part), drawn to compounds and process for preparing wherein the compound has Arylene defined as a carbocyclic or aromatic hydrocarbon and Y is a boroxine (which the examiner assumes is a boron oxygen ring), classified in class 558, subclass various. If this group is chosen please elect a species as a starting point for the group and define the term boroxine as applicant is claiming it.
- V. Claims 1-13 (in part), drawn to compounds and process for preparing wherein the compound has an Arylene is defined as a carbocyclic or aromatic hydrocarbon

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and Y is a heterocyclic ester wherein nitrogen is part of the heterocyclic ring selected from (a) and (e), classified in class 564 , 546, subclass various.

VI-X. Claims 1-13(in part), drawn to compounds and a process for making the compounds wherein Arylene is defined as a heterocyclic moiety and Groups VI-X are the same Y as Groups I-V respectively. The classification would be determined by the heterocyclic moiety and cover 540, 544, 546, 548, 549 and the subclasses would be various. If any of these four Groups are chosen then a species election is required solely as a starting place for the search of the group.

XI. Claims 1-13(in part) drawn to any compounds and methods of preparation not found in the previous groups. If this group is elected a species must be chosen as a starting point for the search of the group. There may also be further restriction required.

The inventions are distinct, each from the other because of the following reasons:

The Groups are both chemical and physical patentably distinct. The first group is a boronic acid group which ends in $B(OH)_2$ and has a hydrocarbon center and the process for producing this moiety. This different from group II which has a $B(OR)_2$ terminal ester group and the method of preparing the group. The group has different properties and is found in a different class. Finding a 102(b) on a compound in Group I would not obviate a rejection over Group II or for that matter over Groups III-IX. Group III is a hydrocarbon arylene group with a boron oxygen ring system. This would give an boron oxygen carbon heterocycle which is different from all the other groups. This group also includes a process of making the compounds. Again these are chemically and physically different from the compounds in any other group. They are

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patentably distinct and they are in a different class. Also an on line search of the group would be a different structural drawing in Chemical Abstracts registry file. Group IV is drawn to the arylene group being a hydrocarbon and the Y group being an boroxine. The examiner searched this term and found it to be rings that contain only oxygen and boron. If this is not what applicant means by the term please clarify. A ring with boron and oxygen only is patentably distinct from the carbon oxygen chains or rings with boron as found in the other groups. Group V is drawn to a boron nitrogen carbon oxygen ring and a process for preparing the ring which is different from the other groups. As for groups VI-X the core is change to a heterocycle and the heterocycle cores are different than the hydrocarbon cores. The processes are making different products starting with different starting materials and the processes and the compounds are different and patentably distinct from the other groups.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Ms Green at Novo Nordisk Phram. on June 9, 2004 to dicuss the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean F. Vollano whose telephone number is 571-2720648. The examiner can normally be reached on Monday-Thursday 6:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272- 0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jean F. Vollano
Primary Examiner
Art Unit 1621

June 9, 2004